APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,269	12/30/2003	Forrest Rhoads	962.016US1	9691

21186   7590   09/06/2007
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER
SYED, FARHAN M

ART UNIT	PAPER NUMBER
2165	

MAIL DATE	DELIVERY MODE
09/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,269	Applicant(s) RHOADS ET AL.
	Examiner Farhan M. Syed	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _22 June 2007_.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims *1-21*

4) ☒ Claim(s) _1-14_ is/are pending in the application.

4a) Of the above claim(s) _15-21_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-14_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _6/22/07_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-14 are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette

et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette).

        As per claim 1, Rivette teaches a computer system comprising: means for

receiving a query from an agent of a law firm (i.e. " Referring again to FIG. 9, the client searching

module 710 generates a query request 908A based on the search criteria that the user entered into the

field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise

server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28,

lines 28-35); means, responsive to the received query (i.e. "The searching module 410 in the

enterprise server 314 receives the query request 908A.")(Column 29, lines 52-54), for searching at

least first and second physical or logical databases for content related to the query (i.e.

" The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct

searches through the data in the databases 316 pursuant to search requests from the clients 304,

306.")(Column 25, lines 39-42), with the first database being a part of an information

management system for the law firm including briefs, client correspondence, advisory

opinions, or legal memoranda of the law firm (i.e. "The present invention also maintains one or

more groups. Each of the groups comprises any number of patents from the first databases.")(Column 3,

lines 64-66) and the second database being external to the information management

system and including case opinions, court documents, law review articles, statutory

materials, or legislative histories (i.e. "The present invention, upon receiving appropriate operator

commands, automatically processes the patents in one or more of the groups in conjunction with non-

patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 2, Rivette teaches a system, wherein the first and second

databases are separated by a firewall (i.e. "The security module 402 performs the steps of

flowchart 11002 to determine whether a user who is requesting an operation involving a data item has

sufficient security access privileges with respect to that data item. Preferably, all operations performed by

the enterprise server 314 are security checked. In other embodiments, only some operations performed

by the enterprise server 314 are security checked. For example, operations involving reading patent

documents are not security checked in some embodiments because patents are widely available public

documents.")(Column 82, lines 1-10).

As per claim 3, Rivette teaches a system: wherein the work product documents

include briefs, client correspondence, advisory opinions, or legal memoranda produced

by the law firm (i.e. "Each of the groups comprises any number of patents from the first

databases.")(Column 3, lines 64-66); and wherein the second databases are part of an online

pay-for-access legal research service (i.e. "The present invention, upon receiving appropriate

operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 4, Rivette teaches a system, wherein the means for receiving a query includes a graphical user interface for displaying a taxonomy of selectable legal topics, with selection of one or more of the legal topics indicative of a query being received (i.e. "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface GUI 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 26, lines 60-67).

As per claim 5, Rivette teaches a system: wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of the documents found by the means for searching, with each displayed portion associated with an indicator of whether the document is a work-product document of the law firm and with a depth-of-treatment indicator indicating a degree of treatment of the legal case within the document (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the

patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents

in the customer's patent repository), only the patents in the current group, or only the current patent.

Other embodiments may restrict searching to specific types of documents or specific predefined groups,

such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups,

etc.")(Column 28, lines 13-28).

As per claim 6, Rivette teaches a system, wherein each displayed portion

associated with an indicator that indicates the document is a work-product document is

further associated with information identifying an author of the document, an office

location of the author, and an identification of documents within a document

management system for the law firm (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of

FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to

search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702

of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG.

57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic

information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's

patent repository), only the patents in the current group, or only the current patent. Other embodiments

may restrict searching to specific types of documents or specific predefined groups, such as all European

patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28,

lines 13-28).

As per claim 7, Rivette teaches a system, wherein the query includes an

identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710

generates a query request 908A based on the search criteria that the user entered into the field driven

GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for

displaying at least a portion of each document found by the means for searching, with

each displayed portion associated with: a selectively displayable table of authorities

listing documents cited within the document; a selectively displayable listing of other

documents citing the document (i.e. "A user can view a document by double-clicking (or use any

other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the

user has selected document D1 (indicated by dotted circle 1852). This results in the document being

displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is

displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window

1806 where text and images of a document are selectively displayed is more particularly shown in FIG.

112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one

window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in

FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11); a selectively displayable listing of work-

product documents citing the document (i.e. "A user can view a document by double-clicking (or

use any other well known GUI technique) on that document in the window 1804. In the example of FIG.

18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document

being displayed in a window 1806. The window 1806 includes a window 1808, where the text of

document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The

example of window 1806 where text and images of a document are selectively displayed is more

particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group

hierarchical structure is shown in one window 1802 and a list of documents is displayed in another

window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 8, Rivette teaches a system, wherein each listed document is

associated with a depth-of-treatment indicator indicating a quantitative and/or qualitative

degree to which the listed document treats the legal case and one or more of the listed

work-product documents are associated with a feedback indicator selectable to view

one or more user comments on the one or more listed work-product documents (i.e. "A

user can view a document by double-clicking (or use any other well known GUI technique) on that

document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated

by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806

includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the

image of document D1 is displayed. The example of window 1806 where text and images of a document

are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where

the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is

displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67;

column 70, lines 1-11).

As per claim 9, Rivette teaches a system, wherein each portion of the documents

found by the means for searching includes a selection device for invoking display of text

of the document, with text including one or more selectable citations to other

corresponding documents and with each citation associated with an indicator of current

reliability of its corresponding document as a legal authority (i.e. "A user can view a document

by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In

the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This This

results in the document being displayed in a window 1806. The window 1806 includes a window 1808,

where the text of document D1 is displayed, and/or a window 1810, where the image of documentD1 is

displayed. The example of window 1806 where text and images of a document are selectively displayed

is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group

hierarchical structure is shown in one window 1802 and a list of documents is displayed in another

window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claims 10-14, Rivette teaches a system comprising providing an interface

for an online legal research service, wherein the interface enables an authorized law

firm user to view search results (i.e. " Referring again to FIG. 9, the client searching module 710

generates a query request 908A based on the search criteria that the user entered into the field driven

GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314.

In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35)

including both internal law-firm content including briefs, client correspondence, advisory

opinions, or legal memoranda of the law firm and content of the online legal research

service, wherein the search results are based on a single query submitted or initiated

through the interface by the user (i.e. "The searching module 410 in the enterprise server 314

interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant

to search requests from the clients 304, 306." "The operation of the client searching module 710 in a

client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in

greater detail with reference to FIG. 9. The client searching module 710 supports a number of user

interfaces for enabling the user to enter a search command. One user interface is a field driven graphical

user interface (GUI) 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 25,

lines 39-42; column 26, lines 60-67).

As per claim 11, Rivette teaches the method wherein the law-firm content is

stored in a law-firm information management system (see item 302, Figure 3) that includes

a document management system (i.e. document databases)(see Figure 6) for the law firm (i.e.

user)(Figure 2) and is separated from the online legal service by a firewall (i.e.

Network)(Figure 3).

Response to Remarks/Argument

4.   Applicant's election with traverse of claims 15-21 in the reply filed on 15 June

2007 is acknowledged. The traversal is on the ground(s) that claims 15-21 are elected

based on original presentation. This is not found persuasive because the scope of the

claims addressed different embodiments such as claim 1 recites the limitations of a

computer system comprising: means for receiving a query from an agent of a law firm;

means, responsive to the received query, for searching at least first and second

physical or logical databases for content related to the query, with the first database

including work-product documents of the law firm and the second database including

non-work product documents.

The requirement is still deemed proper and is therefore made FINAL.

5.   Applicant's arguments, see page 8, filed 15 June 2007, with respect to claim 9

have been fully considered and are persuasive. The objection of a non-final office

action mailed 15 December 2006 has been withdrawn.

6.   Applicant's arguments, filed 15 June 2007, with respect to Figure 1, item 1361E,

1361EE, and 1365 have been fully considered and are persuasive. The objection of a

non-final office action mailed 15 December 2006 has been withdrawn.

7.   Applicant's arguments filed 15 June 2007 have been fully considered but they are

not persuasive for the reasons set forth below.

Applicant argues:

(1) "For example, claim 1 has been amended to recite that the first database

includes briefs, client correspondence, advisory opinions, or legal memoranda of the

law firm and the second database includes case opinions, court documents, law review

articles, statutory materials, and legislative history. A computerized search of Rivette's

text does not reveal no occurrences of the term: brief, opinion, advisory, memorandum,

or memoranda. Thus it does not appear to one of ordinary skill would regard it as

identical meeting this limitation of claims 1-9."

The Examiner disagrees. According to the Applicant's specification, the Applicant

concedes that brief, client correspondence, advisory opinions, or legal memoranda are

documents and according to the Microsoft Computer Dictionary, 5th ed., *"document are*

generally thought of as word-processing materials only. To a computer, however, data is nothing more

than a collection of characters, so a spreadsheet or a graphic is as much a document as is a letter or

report." Therefore, the Examiner understands brief, client correspondence, advisory

opinions, or legal memoranda as data and data may be stored in a database, as taught

by Rivettes (see Figure 6). Furthermore, briefs, client correspondence, advisory opinions,

or legal memoranda are instances of data and is the intended use with the law firm

industry. Similarly, travel data such as flight information, financial information, and

passenger information are data pertinent to the travel industry that would also be stored

in a database. A recitation of the intended use of the claimed invention must result in a

structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. With respect to the

prior art, please see Rivette (column 1, lines 8-10).

(2) "Additionally, claim 1 further requires that the first database be part of an

information management system for the law firm and that the second database be

external to the information management system of the law firm. Rivette does not appear

to meet this requirement either."

The Examiner disagrees. Rivette teaches the first database (Deposition database,

see Figure 6) be part of an information management system (Document Databases)(see Figure

6) for the law firm (i.e. user)(Figure 2) and that the second database (i.e. other database

servers)(Figure 4) be external (i.e. Figure 3) to the information management system (Document

Databases)(see Figure 6) of the law firm.

Hence, the Applicant's arguments do not distinguish over the claimed invention

over the prior art of record.

Any other arguments by the applicant are either more limiting than the claimed

language or completely irrelevant.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.
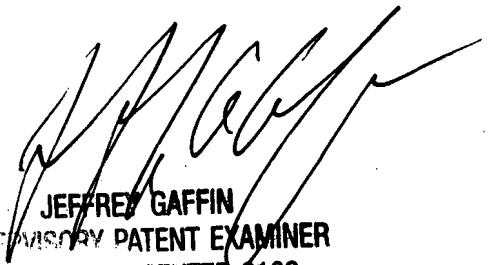
Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Farhan M. Syed whose telephone number is 571-272-

7191. The examiner can normally be reached on 8:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

FMS

JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
ART UNIT 2100